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PCT LEGAL ADMINISTRATION

In re Application of	:	
NUNO, et al.	:	
Application No.: 10/593,717	:	DECISION ON PETITION
PCT No.: PCT/JP2005/005880	:	
Int. Filing Date: 29 March 2005	:	UNDER 37 CFR 1.181
Priority Date: 30 March 2004	:	
Atty Docket No.: 0121/0059	:	
For: ELECTRONIC SERVICE MANUAL	:	
GENERATION METHOD...ARE RECORDED	:	

This is a decision on applicant's "PETITION UNDER 37 CFR 1.181 REQUEST FOR CLARIFICATION (PCT LEGAL)" filed 15 September 2010 in the United States Patent and Trademark Office (USPTO).

On 21 September 2006, applicant filed a transmittal letter for entry into the national stage in the United States which was accompanied by among other items, payment of the requisite basic national fee as required by 35 U.S.C. 371(c)(1).

On 05 June 2007, applicant was mailed a "Notification of Acceptance" (Form PCT/DO/EO/903).

On 15 September 2010, applicant filed the present petition seeking clarification as the USPTO had issued an Office Action based on examination of the original 32 claims of the underlying international application while applicant had filed a PCT Article 34 amendment amending the claims to 28 claims. The petition indicates that applicant was further informed that the USPTO in its capacity as a national stage office under 35 U.S.C. 371 always examines the original claims in an international application and that "what takes place in the PCT application has no bearing on the US application."

Applicant is correct that pursuant to the Manual of Patent Examining Procedure (MPEP) 1893.01(a)(3):

Amendments to the international application that were properly made under PCT Article 34 during the international preliminary examination phase (i.e., Chapter II) will be annexed by the International Preliminary Examining Authority to the international preliminary examination report (IPER) and communicated to the elected Offices. See PCT Article 36, PCT Rule 70.16, and MPEP § 1893.03(e).

However, applicant is advised that in the present application the U.S. examiner did examine the correct set of claims. MPEP 1893.01(a)(3) further states that:

Amendments made under PCT Article 34 to the international application after commencement and entry into the U.S. national phase (see MPEP § 1893.01) will not be considered in a U.S. national stage application. However, applicants may still amend the U.S. national stage application by way of a preliminary amendment submitted in accordance with 37 CFR 1.115 and 37 CFR 1.121.

In the present case, an examination of the International Preliminary Report on Patentability Chapter II (Form PCT/IPEA/409) was not completed by the examining authority until 05 October 2006 and not issued until 10 November 2006; after commencement into the U.S. National stage. Further, while applicant included a copy of the PCT Article 34 amendment on 21 September 2006; this copy was not in the form of a proper preliminary amendment pursuant to 37 CFR 1.115 and 37 CFR 1.121.

In conclusion, applicant is correct that a timely filed PCT Article 34 amendment; annexed in a Form PCT/IPEA/409 prior to commencement in the U.S. National stage will result in the amended claims being examined in the United States. Unfortunately, in the present case the examining authority did not issue the report until the thirty month period had expired.

For the reasons above, applicant's petition under 37 CFR 1.181 is **DISMISSED**.

Any further correspondence with respect to this matter should be directed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration or electronically filed utilizing the USPTO's EFS-Web electronic filing system.



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